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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,265

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Debra K. Stephens

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EXAMINER

CHEN, CHIA WEI A

ART UNIT

PAPER NUMBER

2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/707,265	Applicant(s) STEPHENS, DEBRA K.	
	Examiner Chia-Wei A. Chen	Art Unit 2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/06/2005, 01/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The references listed on the Information Disclosure Statement filed on 06/06/2005 and 01/30/2006 have been considered by the examiner (see attached PTO/SB/08).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1-5, although the preamble of the claims recite "mobile phone" and "camera", the body of the claims include only software program such as "code recorded in the processor readable medium." Absent is the recitation of the necessary hardware to enable the software to act as a computer component and realize its functionality. As such, claims 1-5 are directed toward software per se, which is non-functional descriptive material and therefore it is non-statutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2609

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 6, 8, 10, 12, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (US 5,737,491).

As to claim 10, Allen et al. discloses a combination mobile phone and digital camera comprising:

- a microphone (24) to detect audible input (see col. 2, lines 42-43);
- a database (25) containing entries characterized as camera commands (see col. 2, lines 52-56 and col. 4, lines 14-16);
- and a processor (29) to:
 - process detected audible input ("voice commands"; col. 2, line 55);
 - compare detected audible input to the database of camera commands ("comparing the photographer's digitized voice commands to digital voice templates"; col. 2, lines 55-56);
 - determine if the detected audible input matches one of the camera commands in the database ("the command is 'recognized' by the DSP unit"; col. 4, line 18);
 - and execute a series of instructions associated with a camera command that has matched a detected audible input ("produce a control signal for the camera"; col. 4, lines 19-20).

As to claim 1, this claim differs from claim 10 only in that claim 1 further claims:

- a processor readable storage medium;

Allen teaches the digitized voice commands stored in the code book (25). It is clear that code book (25) is a readable storage medium because it is impossible that the software by itself can store the codes.

Moreover, Allen et al. teaches that "the codebook of the voice recognition module may be located at the image fulfillment server rather than in the camera" (see col. 4, lines 29-31). Thus, it is clear that the codebook (25) can be implemented as a memory hardware module.

- code recorded in the processor readable storage medium to enable audible control of a camera (See Table 1; cols. 3-4).

Art Unit: 2609

Allen et al. teaches the verbal commands *Erase*, *Transmit*, and others. These commands command the camera to perform their associated functions. Thus, it is clear that these audible commands enable audible control of a camera.

As to claim 3, Allen et al. teaches the combination of claim 1, wherein the series of instructions comprises:

- code recorded in the processor readable storage medium to compose a message ("Annotate the digital image with a text message"; col. 3, lines 64-65);
- code recorded in the processor readable storage medium to attach a picture to the message ("Annotate the digital image with a text message"; col. 3, lines 64-65);
- and code recorded in the processor readable storage medium to send the message ("Transmit image with appended control signals" ; col. 4, lines 11-12).

As to claim 6, Allen et al. teaches the combination of claim 3, wherein the message is an e-mail message (col. 2, line 7).

As to claim 8, Allen et al. teaches the combination mobile phone and digital camera of claim 1 wherein the camera is integrated into the mobile phone ("a wireless communication system such as a cellular telephone or a digital wireless communication system."; col. 3, lines 5-7, Fig. 1).

As to claim 12, Allen et al. teaches the combination mobile phone and digital camera of claim 10 wherein the series of instructions comprises:

- composing a message ("Annotate the digital image with a text message"; col. 3, lines 64-65) ;
- and attaching a picture to the message ("Annotate the digital image with a text message"; col. 3, lines 64-65).

As to claim 15, Allen et al. teaches the combination mobile phone and digital camera of claim 12 wherein the message is an e-mail message (col. 2, line 7).

Art Unit: 2609

As to claim 17, Allen et al. teaches the combination mobile phone and digital camera of claim 10 wherein the camera is integrated into the mobile phone ("a wireless communication system such as a cellular telephone or a digital wireless communication system"; col. 3, lines 5-7, Fig. 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US 5,737,491) in view of Hoshino et al. (US 5,027,149).

As to claims 2 and 11, Allen et al. teaches the combination mobile phone and digital camera of claim 1, but does not teach wherein the series of instructions comprises: code recorded in the processor readable storage medium to take a picture.

Art Unit: 2609

Hoshino teaches wherein the series of instructions comprises: code recorded in the processor readable storage medium to take a picture ("voice-recognition circuit outputs signals... which controls individual sections of the camera to take a photograph"; col. 4, lines 54-57).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented the instructions for taking a picture as taught by Hoshino to the camera of Allen so that [the user] can remotely control the camera without errors of vocal instruction registration. (see col. 1, line 18 and col. 7, lines 39-47).

6. Claims 7, 9, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US 5,737,491) in view of Isberg et al. (US 2006/0026202).

As to claims 7 and 16, Allen et al. teaches the combination mobile phone and digital camera of claim 3, but does not teach wherein the message is an MMS message.

Isberg et al. teaches wherein the message is an MMS message ("The control unit packages... the digital image as an MMS message." paragraph [0092]).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the MMS message as taught by Isberg to the message of Allen because the MMS message of Isberg would

Art Unit: 2609

provide a resemblance analysis such as a user's pictures before transmitting to another user; thereby providing MMS message service more attractive to and not jeopardize the user's integrity (see [0006] of Isberg).

As to claims 9 and 18, Allen et al. teaches the combination mobile phone and digital camera of claim 1, but does not teach wherein the camera is attachable to the mobile phone as an accessory.

Isberg et al. teaches wherein the camera is attachable to the mobile phone as an accessory ("Digital camera can be... detachable and, for use, be mounted on the mobile phone by the user." paragraph [0079]).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the camera of Allen to either integrate or make attachable the camera to the mobile phone as taught by Isberg, depending on the manufacturer's decision.

7. Claims 4, 5, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US 5,737,491) in view of Enns et al. (US 7,082,298 B2).

As to claims 4 and 13, Allen et al. teaches the combination mobile phone and digital camera of claim 3, but does not teach wherein the code recorded in the processor readable storage medium to compose a message comprises: code recorded in the processor readable storage medium to address the message to

Art Unit: 2609

one or more recipients; and code recorded in the processor readable storage medium to insert text to the message.

Enns et al. teaches wherein the code recorded in the processor readable storage medium to compose a message comprises:

- code recorded in the processor readable storage medium to address the message to one or more recipients ("*Add To*: allows the user to identify additional recipients"; col. 6, line 10); and
- code recorded in the processor readable storage medium to insert text to the message ("The user adds reply text by selecting *Insert Text*"; col. 6, lines 11-12).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the addressing of multiple recipients and the insertion of text as taught by Enn to the message of Allen so that the user does not have to retype the message which can be quite cumbersome (see col. 1, lines 55-61).

As to claims 5 and 14, Allen et al. teaches the combination mobile phone and digital camera of claim 3, but does not teach wherein the code recorded in the processor readable storage medium to compose a message comprises: code recorded in the processor readable storage medium to address the message to one or more recipients; and code recorded in the processor readable storage medium to attach audio to the message.

Enns et al. teaches wherein the code recorded in the processor readable storage medium to compose a message comprises:

- code recorded in the processor readable storage medium to address the message to one or more recipients ("*Add To*: allows the user to identify additional recipients"; col. 6, line 10); and

Art Unit: 2609

- code recorded in the processor readable storage medium to attach audio to the message ("The selection of *Insert Voice*... allows for the addition of audio content to the reply message."; col. 6, lines 22-23)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the attachment of audio to a message as taught by Enn to the message of Allen for the same reasons as previously discussed with respect to claims 4 and 13 above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kleinschmidt et al. (US 6,085,112) discloses a communication device with a wide variety of components such as speech input and output devices, image display devices and a computer.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chia-Wei A. Chen whose telephone number is 571-270-1707. The examiner can normally be reached on Monday - Friday, 7:30 - 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on 571-272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

C. Chen
December 19, 2006


CHANH D. NGUYEN
SUPERVISORY PATENT EXAMINER